

In re Patent Application of
BARDWELL
Serial No. 10/081,886
Filed: FEBRUARY 22, 2002

REMARKS

Applicants again thank the Examiner for the careful and thorough examination of the present application, for correctly withdrawing the previous rejection, and for the indication of allowable subject matter. Claims 1-21 remain pending in the application. Favorable reconsideration is respectfully requested.

I. The Invention

A concise explanation of the invention is included here. The disclosed invention is directed to a biometric identification and verification system and method including the use of biometric data and a PIN. The features of the invention are provided by a method for storing biometric information on a token having a magnetic storage medium, such as a magnetic stripe. The method includes capturing a biometric image and generating biometric data therefrom, obtaining a personal identification number (PIN) and storing the biometric data and the PIN on the magnetic storage medium of the token.

II. The Claims are Patentable

Claims 1-4, 6 and 7 were rejected in view of Jeffers et al. (U.S. 5,613,712) and Baratelli (U.S. 6,325,285) taken together or in combination with Lasch et al. (U.S. 6,581,839) for the reasons set forth on pages 2-4 of the Office Action. Claims 5 and 8-21 were indicated as being directed to allowable subject matter. Applicant contends that Claims 1-4,

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6 and 7 clearly define over the cited references, and in view of the following remarks, favorable reconsideration of the rejections under 35 U.S.C. §103 is requested.

Independent Claim 1, includes capturing a biometric image and generating biometric data therefrom, obtaining a PIN, and storing the biometric data and the PIN on a magnetic storage medium. It is this combination of features which is not fairly taught or suggested in the cited references and which patentably defines over the cited references.

The Examiner has now relied on the Jeffers patent as disclosing the storing of "a magnetic fingerprint" and "encoded information" on a card. More specifically, the Jeffers patent is directed to a magnetic fingerprint image created by having the user coat a finger tip with a magnetic powder and transfer the powder particles to a document/card surface. The magnetic fingerprint image is then covered by a thin, non-removable plastic film that is optically opaque but is magnetically transparent. The print is scannable by a magnetic head whose output signal consists of a sequence of electrical waveforms characteristic of the ridges and depressions that define the fingerprint. The rotation angle of the image is stored as encoded information on the surface of the document.

However, in Jeffers, there is no teaching of storing a captured biometric image as biometric data on a magnetic storage medium as claimed. Indeed, Jeffers does not disclose generating biometric data from the magnetic powder fingerprint image at all, much less storing such data on a magnetic

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storage medium. Indeed, the document is not magnetic and cannot be considered to be a magnetic storage medium as described in the present specification and as given the term's ordinary meaning and/or dictionary definition.

Furthermore, the Examiner correctly points out that Jeffers also does not teach the use of a PIN on a magnetic medium, as claimed.

However, the Examiner again relies upon the Baratelli patent as teaching the use of a PIN and fingerprint information stored in an integrated circuit memory of a smart card. As discussed previously, the Baratelli patent discloses a smart card including a CPU, memory, and a fingerprint reader including a sensing surface. When an individual inserts the smart card into a write/read unit, the smart card creates an electrical representation of the individual's fingerprint and compares the acquired representation to a stored fingerprint representation in the card's memory. The memory in Baratelli is a semiconductor or static memory such as a RAM, ROM or EEPROM. There is no magnetic medium or stripe in Baratelli and consequently no teaching of storing biometric data and/or a PIN on a magnetic medium. Accordingly, nothing in Baratelli makes up for the deficiencies of the Jeffers patent as noted above.

Again, Applicant points out that the Examiner is impermissibly using the teachings of Applicant's own patent application as a roadmap to modify the prior art. For example, as noted above, the method and apparatus of Jeffers uses a transferred magnetic powder fingerprint image on the surface

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of a document or card without the use of a PIN, while the Baratelli patent is directed to a smart card having a RAM or EEPROM. The skilled artisan would clearly recognize the storage capacity differences between a transferred magnetic powder fingerprint image on the surface of a card versus information stored in a RAM or EEPROM of a smart card. Again, neither reference discloses or teaches storing biometric data and/or a PIN on a magnetic medium of a token as claimed.

Additionally, Applicant again specifically traverses the Examiner's obviousness assertion regarding the Lasch et al. patent. Nothing in either the Lasch et al. patent or the ISO 7810 standard mentions or suggests the storage of biometric/fingerprint data on the third track of the magnetic stripe. This argument was previously presented by Applicant and has not been addressed by the Examiner.

The Examiner is reminded that to establish a prima facie case of obviousness there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Also, the prior art references must teach or suggest all the claim features. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the Applicant has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the reference must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in

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light of the teachings of the reference. Both the suggestion to make the claimed combination and the reasonable expectation of success must be founded in the prior art and not in Applicant's disclosure.

There is simply no teaching or suggestion in the cited references to provide the combination of features as claimed. Accordingly, for at least the reasons given above, Applicant maintains that the cited references do not disclose or fairly suggest the invention as set forth in Claim 1. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. Thus, the rejections under 35 U.S.C. §103(a) should be withdrawn.

It is submitted that independent Claim 1 is patentable over the prior art. In view of the patentability of such independent claim, it is submitted that the dependent claims, which recite yet further distinguishing features are also patentable over the cited references for at least the reasons set forth above. Accordingly, these dependent claims require no further discussion herein.

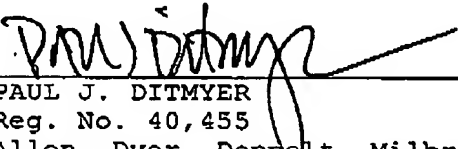
III. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. An early notice thereof is earnestly solicited. If, after reviewing this Response, there are any remaining informalities which need to be resolved before the application can be passed to issue, the Examiner is invited and

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respectfully requested to contact the undersigned by telephone
in order to resolve such informalities.

Respectfully submitted,


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CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY that the foregoing correspondence has
been forwarded via facsimile number 703-872-9306 to the
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-
1450 this 7th day of July, 2004.

